

referred to as “the ‘026 patent”). In addition to Wiggs et al. and the ‘026 patent, U.S. Patent No. 5,624,439 is applied in the rejections of claims 6 and 13. Thus, the ‘026 patent is used in the rejection of all pending claims.

Applicants traverse the rejection of all the claims on the grounds that 35 U.S.C. § 103(c) disqualifies using the ‘026 patent in a rejection under 35 U.S.C. § 103(a) against the claims of the subject application.

According to 35 U.S.C. § 103(c), “[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of [Title 35 of the United States Code], shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.”

Here, the subject application (Application 09,296,040) and the ‘026 patent were, at the time the invention of Application was made, owned by Broncus Technologies, Inc. The ‘026 patent is therefore not available for use in a rejection under 35 U.S.C. § 103(a) against the subject claims.

The other patents do not support an obvious rejection without the ‘026 patent. Consequently, Applicants submit that the grounds for rejection under 35 U.S.C. § 103(a) have been overcome and request that the rejection be withdrawn.

Accordingly, reconsideration and withdrawal of the rejections of all the claims is respectfully requested.

CONCLUSION

Applicants have responded to each rejection raised in the Office Action dated March 14, 2001. Applicants submit that the pending claims overcome the rejections. Accordingly,

reconsideration and allowance of the pending claims are respectfully requested. If it is determined that a telephone conversation would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorizes the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 435712000920. However, the Assistant Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

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